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PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		FELD3002CIP1/ESS	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on		Application Number	Filed
		10/609,383	July 1, 2003
		First Named Inventor	
Signature		Richard J. Feldmann	
Typed or printed name		Art Unit	Examiner
		1631	John S. Brusca
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <ul style="list-style-type: none"><li><input type="checkbox"/> applicant/inventor.</li><li><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</li><li><input checked="" type="checkbox"/> attorney or agent of record. Registration number</li><li><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</li></ul> <div style="text-align: right;"> _____ Signature Eric S. Spector _____ Typed or printed name 703-683-0500 _____ Telephone number _____ August 20, 2008 _____ Date</div> <p>Bacon &amp; Thomas, PLLC, Customer No. 23364</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of                      forms are submitted.</p>			



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re U.S. Patent Application**

**Richard J. FELDMANN**

**Application Number: 10/609,383**

**Filed: July 1, 2003**

**Examiner: John S. Brusca**

**Group Art Unit: 1631**

**Confirmation No.: 4498**

**Attny Dkt No.: FELD3002CIP1/ESS**

**For: MODIFYING THE CONTROL OF GENE EXPRESSION BEHAVIOR BY  
THE DELETION OF CONNECTRONS AND BY THE DESIGN AND  
ADDITION OF SYNTHETIC CONNECTRONS IN PROKARYOTIC,  
ARCHEA AND EUKARYOTIC GENOMES**

**PRE-APPEAL REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Concurrently filed is a Notice of Appeal.

This paper is being submitted because there is a clear deficiency on what the rejection and advisory action rely on for who has the burden of proof in lack of enablement rejections and there is a clear deficiency in the evidence the rejection and Advisory Action rely on to establish a *prima facie* case.

There is a single issue, i.e. whether claims 1 and 2 meet the enablement requirement of 35 U.S.C. 112, first paragraph.

Regardless of what the Office Action says the law is or the MPEP indicates the law is, the relevant case law provides that the burden is on the PTO to provide by evidence or suitable reasoning that there is unpredictability involved in the practice of

the claims. See the case law cited in the response of March 27, 2008. No case law is cited in the final action which says otherwise. The rejection and Advisory Action take the position that no evidence or reasoning is necessary because their position is based on compliance with the Wands factors; no case law is cited which indicates that application of the Wands factors changes the established law that the burden is on the PTO to establish unpredictability by evidence and reasoning.

It is noted that the undersigned has been involved in at last ten appeals on the issue set forth here. In all cases, the decision on appeal supported what the undersigned says is the law and a patent issued or the PTO withdrew its objection.

One relevant decision where the undersigned was involved is the decision on appeal in 09/757,610. A salient portion of the decision is quoted below.

“[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.” In re Marzocchi, 439 F.2s 220, 2223, 169 USPQ 367, 369 (CCPA1971) (emphasis original). “[I]t is incumbent upon the Patent Office . . . to explain why it doubts the truth and accuracy of any statement in the supporting

disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” Id. at 224, 169 USPQ at 370. In other words, “the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by [the] claim[s] is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specifications as to the scope of enablement.” In re Wright, 999 F.2d 1557, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Thus, the issue is not whether appellants have established that the disclosure is enabling for the scope of the claims; the issue is whether the PTO has met its initial burden of setting forth a reasonable explanation as to why it is not.

Thus the issue is whether the PTO has carried its burden of proving unpredictability for practice of the claims.

We turn now to whether or not the PTO has carried its burden for proving the unpredictability in the practice of the claims.

The Office Action relies only on Mattick and Chan et al. for evidence (see pages 6 and 7 of the final action.).

The PTO position on Mattick (page 5 of the final action), is that it is silent on whether connectrons are present. Applicant's position in response is that silence is not probative so Mattick proves nothing.

We turn now to Chan et al.

The final Office Action at pages 5 and 6 says:

Chan et al. describes on pages 268-273, the unpredictability and difficulty of forming triplex structures that are linked to the purine motif or the pyrimidine motif.

At page 6, the final Office Action states:

Chan et al. shows that triplex formation occurs only with oligonucleotides with a purine rich or pyrimidine rich motif, rather than with any identical sequence as suggested in the specification.


In reply, applicant finds that Chan et al. provides no data at all of its own and therefore shows nothing about triplex formation. The statements in Chan relied on in the final Office Action are rather conclusions based on hearsay recitations. Hearsay is not probative so Chan proves nothing.

Thus the PTO has failed to carry its burden.

Serial Number: 10/609,383  
Attorney Docket: FELD3002CIP1/ESS

Withdrawal of the rejection and allowance is requested.

Respectfully submitted,  
BACON & THOMAS, PLLC

By:   
Eric S. Spector  
Registration No. 22,495

BACON & THOMAS, PLLC  
Customer **23364**  
625 Slaters Lane - 4<sup>th</sup> Floor  
Alexandria, VA 22314-1176  
Telephone: (703) 683-0500  
Facsimile: (703) 683-1080

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